

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:

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PCT

WRITTEN OPINION

(PCT Rule 66)

Date of mailing
(day/month/year)

18. 08. 98

Applicant's or agent's file reference

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REPLY DUE

within **3 month(s)**
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International application no.

PCT/US97/22136

International filing date (day/month/year)

11/12/1997

Priority date (day/month/year)

13/12/1996

International Patent Classification (IPC) or both national classification and IPC

G07F19/00

Applicant

CERTCO, LLC et al.

1. This written opinion is the **first** drawn up by this International Preliminary Examining Authority.

2. This report contains indications relating to the following items:

- I ☒ Basis of the opinion
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☒ Lack of unity of invention
- V ☐ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☒ Certain defects in the international application
- VIII ☒ Certain observations on the international application

3. The applicant is hereby **invited to reply** to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also: For an additional opportunity to submit amendments, see Rule 66.4.
For the examiner's obligation to consider amendments and / or arguments, see Rule 66.4bis.
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary

-examination report must be established according to Rule 69.2 is: 13/04/1999

Name and mailing address of the international
preliminary examining authority

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WRITTEN OPINION

International application No. PCT/US97/2213

I. Basis of the opinion

1. This opinion has been drawn on the basis of (*substitute sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed".*):

Description, pages:

1-103 as originally filed

Claims, No.:

1-61 as originally filed

Drawings, sheets:

1/12-12/12 as originally filed

2. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

3. This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)):

4. Additional observations, if necessary:

IV. Lack of unity of invention

1. In response to the invitation (Form PCT/IPEA/405) to restrict or pay additional fees, the applicant has:

- ☐ restricted the claims.
- ☐ paid additional fees.
- ☐ paid additional fees under protest.
- ☐ neither restricted nor paid additional fees.

2. This Authority found that the requirement of unity of invention is not complied with for the following reasons and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees:

see separate sheet

3. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this opinion:

☒ all parts.

☐ the parts relating to claims Nos. .

VII. Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

see separate sheet

concerning section IV

- 1). The present application contains eight independent method claims (claims 1, 26, 27, 29, 33, 34, 42 and 48) and one independent claim for an electronic transaction system (claim 23).

The concept which is common to all independent claims is that a certification is issued to a subscriber by a certification authority.

The condition that the certification represents an attestation of a function of a public key is only defined in independent claims 1, 23, 26.

In document "iKP- A family of secure electronic payment protocols" cited in the international search report reference is made to a certification authority infrastructure and to the validation of a public key via a signed certificate (see the paragraph bridging pages 89 and 90). The concept common to the present independent claims 1, 23, 26, 27, 29, 33, 34, 42 and 48 is not therefore novel and these claims are not so linked as to form a single general inventive concept (Rule 13.1 PCT).

concerning section VII

- 2). Contrary to the requirements of Rule 5.1(a)(ii) PCT no relevant background art (eg. as disclosed in the documents cited in the search report) is mentioned in the description, nor are such documents identified therein.

The description is not in conformity with the claims as required by Rule 5.1(a)(iii) PCT. In the description on page 8, line 21 to page 17, line 25 reference is made to the content of claims 1 to 47. The remaining claims 48 to 61 are not mentioned at all.

concerning section VIII

- 3). Considering the excessive number of independent claims in the same category the set of claims appears to lack conciseness. Moreover, lack of clarity of the

claims as a whole arises, since the plurality of independent claims makes it difficult, if not impossible, to determine the matter for which protection is sought, and places an undue burden on others seeking to establish the extent of the protection.

Hence, claims 1, 26, 27, 29, 33, 34, 42 and 48 do not meet the requirements of Article 6 PCT.

general remarks

- 4). Having regard to the aforementioned objections the examination cannot at present be carried out.

The applicant is invited to amend the set of claims to overcome the objections under paragraphs 1). to 3). above. In case the applicant considers it necessary to maintain more than one independent method claims sound reasons therefor should be communicated.

Further, the applicant should explain the single general **inventive** concept linking these independent claims supporting the requisite unity of invention (Rule 13.1 PCT) and the existence of a technical relationship involving one or more of the same or corresponding special technical features in the sense of Rule 13.2 PCT.